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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,949	08/10/2001	Joseph S. Parcels	MM1-105	5403

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EXAMINER

ROSSI, JESSICA

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 04/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/927,949		PARCELS, JOSEPH S.	
	Examiner		Art Unit	
	Jessica L. Rossi		1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/28/04, Response.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18,20-27 and 32-36 is/are pending in the application.
- 4a) Of the above claim(s) 1-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18,20-27,32-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Response

1. This action is in response to the response dated 1/28/04. Claims 1-18, 20-27, and 32-36 are pending. Claims 1-17 are withdrawn without traverse.
2. Please note that the clean copy of the amended claims filed on 6/27/03 does not correspond to the marked-up copy filed that same day. Specifically, the clean copy of claim 18 uses labels i-p while the marked-up copy uses labels a-h. It is suggested to fix the clean copy accordingly.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 18, 20-27, and 32-36 **stand** rejected under 35 U.S.C. 103(a) as being unpatentable over Parcels (US 6018934; of record) in view of Kuhn et al. (US 5711426; of record) and Doll (US 3725170; of record), as set forth in paragraph 4 of the previous office action dated 8/28/03.

***Please note that the primary reference to Parcels (issued 2/1/00) has the same inventive entity as the present application (actual and effective filing date of 8/10/01) while also being available as prior art under 102(b).**

With respect to claims 18, 24, and 36, Parcels teaches an apparatus for folding a corner protector 40 about a corner of a frame and attaching it thereto (abstract). The apparatus of Parcels is identical to that of the present invention as clearly depicted in Figures 7-11 of the reference (also note claims 7-23), except that Parcels teaches a staple head 91 attached to a vertically moveable base for stapling the folded flaps of the corner protector together (Figure 12;

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column 9, lines 12-14) instead of means for depositing first and second quantities of adhesive. It is noted the present invention discloses the “means” for depositing the first and second quantities of adhesive being spray nozzles attached to a vertically moveable base (see reference number 108 in Figures).

It is known in the art to join the folded flaps of a corner protector using either staples or adhesive, as taught by the prior art referred to by Kuhn (Figure 8; column 1, lines 34-37 and 41-45). It is also known in the art to apply adhesive to the flaps of a corner protector using means such as movable spray nozzles prior to joining the flaps to form the protector, as taught by Doll (column 1, lines 25-26; column 5, lines 37-43).

One reading Parcels as a whole would have appreciated that the reference is concerned with the parts of the apparatus used for folding the flaps of a corner protector about a corner of the frame and **not** with the means for attaching these folded flaps to each other; therefore it would have been obvious to attach spray nozzles to the vertically moveable base of Parcels in place of the staple head because using adhesive as an alternative to staples is known in the corner protector art, as taught by Kuhn and Doll, wherein adhesive provides a more aesthetically pleasing product because unlike staples it would not be visible to the user.

Regarding claims 20-22, 25-27, and 32-34, Parcels teaches all the limitations (Figures 7-11; claims 7-23).

Regarding claims 23 and 35, Doll teaches the adhesive applying means being an applicator head with at least one nozzle (column 5, lines 40-43).

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 18, 20-27, and 32-36 **stand** rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 22-27 and 29-40 of U.S. Patent No. 6,418,700 in view of Kuhn et al. and Doll et al, as set forth in paragraph 6 of the previous office action.

Please note that '700 to Parcels, which is not available as prior art under 102(b), 102(a), or 102(e), discloses teachings substantially the same to those of '934 to Parcels; therefore, Applicants are invited to reread the 103(a) rejection set forth above for motivation to use an adhesive applying means as an alternative to a stapling means.

Response to Arguments

7. Applicant's arguments filed 1/28/04 have been fully considered but they are not persuasive.

8. On pages 1-2 of the arguments, Applicant argues that Parcels '934 does not disclose or even remotely suggest spraying a first quantity of adhesive onto a frame to secure a flap of a corner protector to the frame or spraying a second quantity of adhesive onto a folded flap of a corner protector to secure a pair of the corner protector flaps together.

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First, Applicant is reminded that examined claims 18, 20-27, and 32-36 are apparatus claims and not method claims. Therefore, it is pointed out that the material worked upon (frame, corner protector) and the manner in which the apparatus cooperates with the material worked upon gets no weight in an apparatus claim (see MPEP § 2115). However, the apparatus of Parcels '934 in view of Kuhn and Doll – spray nozzles attached to vertically moveable base – would be capable of applying adhesive to both the frame and corner protector.

9. On pages 2 and 4 of the arguments, Applicant argues that Kuhn and Doll both fail to teach or suggest forming a corner protector in situ around the corner of a frame, depositing a first quantity of adhesive onto the frame, and depositing a second quantity of adhesive onto a folded flap of the corner protector.

The examiner respectfully points out that Kuhn and Doll were only used to show that it is known in the art to use adhesive as an alternative to staples when assembling corner protectors wherein the adhesive is applied using moveable spray nozzles. As for the adhesive being applied to the frame and/or flap of the protector, Applicant is invited to reread paragraph 8 above regarding the material worked upon.

10. On page 2 of the arguments, Applicant disagrees with the examiner's statement that Parcels '934 has the same inventive entity as the present application. Applicant argues that the apparatus of Parcels '934 is not the same as that of the claimed invention.

The examiner respectfully points out that "inventive entity" means the inventor(s) and not the invention.

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11. On page 3 of the arguments, Applicant argues that the means plus function language relating to deposition of the adhesive defines an apparatus which is patentably distinct over Parcels '934.

Applicant is invited to reread the 103 rejection set forth above in paragraph 4.

12. On page 5 of the Arguments, Applicant argues that the obvious double patenting rejection with Parcels '700 should be removed because this reference fails to teach or suggest means for depositing first and second quantities of adhesive.

Applicant is invited to reread paragraphs 8-11 above.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

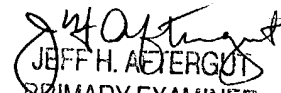
Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **571-272-1223**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard D. Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jessica L. Rossi
Patent Examiner
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